

REMARKS

By this amendment, no claims have been amended, cancelled, or added. Hence, Claims 1-23 and 49-71 are pending in the application.

THE OBJECTIONS/REJECTIONS TO THE CLAIMS

Claims 2-5, 12, 50-53, and 60 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

Claims 1, 10, 18, 20-23, 49, 58, 66, and 68-71 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,924,096 issued to Draper et al. ("*Draper*") in view of U.S. Patent Number 6,453,404 issued to Bereznyi et al. ("*Bereznyi*"). Claims 6-9 and 54-57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Draper* in view of *Bereznyi* in view of U.S. Patent Number 5,659,682 issued to Devarakonda et al. ("*Devarakonda*"). Claims 13 and 61 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Draper* in view of *Bereznyi* in view of *Devarakonda* in view of U.S. Patent Number 6,032,188 issued to Maris et al. ("*Maris*") in view of U.S. Patent Number 6,243,814 issued to Matena et al. ("*Matena*"). Claims 14, 16, 62, and 64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Draper* in view of *Bereznyi* in view of *Devarakonda* in view of *Maris*. Claims 15 and 63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Draper* in view of *Bereznyi* in view of *Devarakonda* in view of *Maris* in view of U.S. Patent Number 6,012,085 issued to Yohe et al. ("*Yohe*"). Claims 17 and 65 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Draper* in view of *Bereznyi* in view of *Devarakonda* in view of *Maris* in view of U.S. Patent Number 5,933,849 issued to Srbljic et al. ("*Srbljic*"). Claims 11 and 59 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Draper* in view of *Bereznyi* in view of U.S. Patent Number 5,999,940 issued to Ranger et

al. (“*Ranger*”). Claims 19 and 67 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Draper* in view of *Bereznyi* in view of U.S. Patent Number 6,832,120 issued to Frank et al. (“*Frank*”).

Applicants respectfully traverse.

**THE OFFICE ACTION FAILS TO PRESENT A PRIMA FACIE CASE OF
OBVIOUSNESS UNDER 35 U.S.C. § 103(a) AS A MATTER OF LAW**

35 U.S.C. § 103(a) states:

“A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the **subject matter sought to be patented** and the prior art are such that the subject matter **as a whole** would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains” (emphasis added).

Thus, as a matter of law, to present a prima facie case of obviousness under 35 U.S.C. § 103(a), the differences between the subject matter sought to be patented and the prior art must be such that the **subject matter sought to be patented as a whole** would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

The Patent Office has long recognized that a proper rejection based on 35 U.S.C. § 103(a) must allege that the subject matter sought to be patented as a whole must be disclosed or taught by the prior art. MPEP § 2106, II, C states:

[W]hen evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claims as a whole must be considered. (emphasis in original)

Thus, to establish a prima facie case of obviousness as a matter of law, the claimed limitations, as a whole, must be alleged to be taught or suggested by the prior art. Merely

dissecting a claimed invention into discrete elements, and then evaluating the dissected elements in isolation fails to present a prime facie case of obviousness as a matter of law.

Applicant admits to being perplexed about how to respond to the inconsistency between (1) the evidence required to support an obviousness rejection, and (2) the evidence that has been repeatedly offered by the Office Actions relating to the present application. Specifically, to support an obviousness rejection, the Applicant would expect an argument that has the following form: (1) element X is shown in reference A, (2) element Y is shown in reference B, and (3) there is some actual suggestion to combine the references A and B to create the mechanism or technique that has both elements X and Y.

However, the Office Action does not support the obviousness rejections in that manner. Rather, to support the obviousness rejections, not only has each claim been divided into its constituent elements, but also each constituent element of the claim has been finely dissected into a set of short phrases and sentence fragments. The Office Action then points out how each individual fragment corresponds to a similar fragment in any one of a handful of references. The fragment-to-prior-art correlation appears to have been made without any consideration as to the relationship between the fragments, the meaning of the elements as a whole, and the meaning of the claim as a whole.

None of the nine cited references have been cited to disclose, teach, or suggest a single element of any of the independent claims. For example, with respect to Claim 1, none of the nine cited references have been cited to disclose, teach or suggest:

“modifying the data item in a first node of said multiple caches to create a modified data item”

OR

“sending the modified data item from said first node to a second node of said multiple caches without durably storing the modified data item from said first node to persistent storage”

OR

“after said modified data item has been sent from said first node to said second node, said first node sending a request to a master of said data item for writing said data item to persistent storage”

OR

“in response to said request, said master coordinating with said multiple caches to cause said data item to be written to persistent storage”

Instead, the Office Action dissects the claimed elements into discrete elements and then evaluates the dissected elements in isolation, rather than considering the elements as a whole. As an example of a evaluating a dissected element in isolation, *Bereznyi* is cited to show “without durably storing,” but is not cited to show the subject matter, as a whole, of any element recited in Claim 1.

Accordingly, it is submitted that the Office Action fails to present a prima facie case of obviousness under 35 U.S.C. § 103(a) as a matter of law. As a consequence, it is respectfully submitted that the rejection made to Claims 1-23 and 49-71 under 35 U.S.C. § 103(a) may not be properly maintained. Therefore, each of Claims 1-23 and 49-71 are patentable over the cited art and each of Claims 1-23 and 49-71 are in condition for allowance.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any fee shortages or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP



Edward A. Becker
Reg. No. 37,777


2055 Gateway Place, Suite 550
San Jose, CA 95110-1089
(408) 414-1080 ext. 204
Date: **March 30, 2006**
Facsimile: (408) 414-1076

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Mail Stop Amendment**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

On March 30, 2006

By


Angelica Maloney